

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76961

Makoto KITANO, et al.

Appln. No.: 10/647,454

Group Art Unit: 1794

Confirmation No.: 3244

Examiner: Marie Rose Yamnitzky

Filed: August 26, 2003

For: POLYMER COMPOUND AND POLYMER LIGHT-EMITTING DEVICE USING THE
SAME

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

MAIL STOP PATENT EXTENSION

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In view of the patent term adjustment (PTA) of 0 days reported in the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) dated November 5, 2009, Applicant requests reconsideration under 37 C.F.R. § 1.705(b) because the PTA reported by the USPTO did not take into consideration the period of time which was prior to the filing of a Request for Continued Examination, but after the 3-year date recited in 37 C.F.R. § 1.703(b).

In summary, Patentee requests the correction of the PTA reported in the November 5, 2009 Determination from 0 days to 417 days.

In accordance with 37 C.F.R. § 1.705(b), this Application for Patent Term Adjustment is being filed not later than the payment of the issue fee in the present application, and is therefore timely filed. The Director is authorized to charge Patentee's Deposit Account 19-4880 for the required fee as specified in 37 C.F.R. § 1.18(e) (\$200.00).

As required by § 1.705(b)(2), a Statement of the Facts is set forth below. For the purposes of clarity, references to "this Application" refer to the present Application for Patent

Term Adjustment, whereas references to “the ‘454 Application” refers to the present U.S. Application No. 10/647,454.

I. STATEMENT OF THE FACTS

A. The correct patent term adjustment and the basis or bases under §1.702 for the adjustment

Pursuant to §§ 1.702(a) and (b) Applicant submits that the total correct patent term adjustment for the ‘454 Application, as reported in the Determination of Patent Term Adjustment, should have been 471 days. This number is derived from the sum of the delay attributable to the USPTO under §§ 1.702(a-e) (915 days), minus the sum of the delay attributable to Applicant under § 1.704 (444 days). Applicant’s position is set forth in more detail below. For the Commissioner’s convenience, Applicant includes herewith the transaction history of the present application as reported in PAIR, which shows all of the dates on which transactions took place in the present application (including those dates and transactions not discussed here because they do not involve delay), as Appendix 1.

B. Delay attributable to the USPTO (the relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought)

Applicant respectfully submits that the total delay attributable to the USPTO under 37 C.F.R. § 1.703 is 915 days. The delay attributable to the USPTO stems from (1) a delay of 336 days under 37 C.F.R. § 1.703(a)(1); (2) a delay of 30 days under 37 C.F.R. § 1.703(a)(2); and (3) a delay of 549 days under 37 C.F.R. § 1.703(b).

Regarding the first, 336 day, delay, Applicant notes that the ‘454 Application fulfilled the requirements of 35 U.S.C. § 371 on August 26, 2003. However, the first Office Action did not issue in the ‘454 Application until September 27, 2005. 37 C.F.R. § 1.702(a)(1) specifies in relevant part that USPTO delay will be calculated as “[t]he number of days...in the period beginning on the day after the date that is fourteen months after the date on which the application

... fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of [] an action under 35 U.S.C. 132.” 336 days passed between the fourteen-month anniversary of the ‘454 Application’s fulfillment of the requirements of 35 U.S.C. § 371 (October 26, 2004) and the date that the September 27, 2005 Office Action was mailed (including the date of mailing of the Office Action). Accordingly, this period accounts for the first 336 days of USPTO delay.

The second USPTO delay, of 30 days, results from the delay between Applicant’s November 20, 2006 Amendment and the April 19, 2007 Office Action that responded to that Amendment. 37 C.F.R. § 1.703(a)(2) states in relevant part that USPTO delay will be calculated as “[t]he number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132....” There were 30 days between the 4-month anniversary of the filing of the November 20, 2006 Amendment (i.e., March 20, 2007) and the April 19, 2007 Office Action. Thus, this period accounts for 30 days of USPTO delay.

The third period of USPTO delay, which does not appear to have been considered by the USPTO, is a delay of 549 days, which is the number of days between the 3-year anniversary of the 371 filing date of the ‘454 Application and the date on which a Request for Continued Examination was filed. 37 C.F.R. § 1.703(b) specifies in relevant part that USPTO delay includes “the number of days...in the period beginning on the day after the date that is three years after the date on which the...national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date that the patent was issued.” 37 C.F.R. § 1.703(b)(1) limits this by stating that delay under 37 C.F.R. § 1.703(b) does not include “[t]he number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.” Thus, the relevant “end” date for the purposes of the present calculation is the date on which the Request for Continued Examination was filed in the ‘454 Application. There were 549 days between the 3-year anniversary of the 371 filing date of the present

application (i.e., August 26, 2006) and the February 26, 2008 filing of a Request for Continued Examination. Accordingly, this period accounts for 549 days of USPTO delay.

None of the USPTO delay under 37 C.F.R. §§ 1.703(a)(1), (a)(2), and 1.703(b) overlap with each other, and thus the total amount of USPTO delay is the sum total of the delay under each of these sections, as per the Federal Circuit's recent ruling in *Wyeth v. Kappos*, U.S. App. LEXIS 300 (Fed. Cir. Jan. 7, 2010).

Accordingly, Applicant respectfully submits that the delay attributable to the USPTO under 37 C.F.R. § 1.703 is 915 days.

C. Delay attributable to Applicant (any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination as set forth in § 1.704)

Applicant respectfully submits that the total delay attributable to the Applicant under 37 C.F.R. § 1.704 is 444 days. This delay stems from (1) 419 days of total delay under 37 C.F.R. § 1.704(b); and (2) 25 days of delay under 37 C.F.R. § 1.704(c)(8).

Regarding the 419 days of delay under 37 C.F.R. § 1.704(b), Applicant notes that the regulation states in relevant part that an Applicant incurs delay equal to the "cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request." In this regard, Applicant responded to the September 27, 2005 Restriction Requirement on February 27, 2006, incurring 62 days of delay. Applicant responded to the May 19, 2006 Office Action on November 20, 2006, incurring an additional 93 days of delay. Further, Applicant responded to the April 19, 2007 Office Action on October 18, 2007, resulting in 91 days of delay. Applicant's Amendment of September 29, 2008 in response to the Office Action of April 10, 2008 resulted in 81 days of delay. Finally, Applicant responded to the January 5, 2009 Office Action on July 6, 2009, incurring 92 days of delay. Accordingly, the total delay for Applicant under 37 C.F.R. § 1.704(b) is 419 days.

With respect to the 25 day delay under 37 C.F.R. § 1.704(c)(8), Applicant notes that this regulation states in relevant part that “[s]ubmission of a supplemental reply or other paper” may constitute delay. Accordingly, the submission of the Supplemental Amendment of December 15, 2006 (supplemental to the Amendment of November 20, 2006) resulted in a delay of 25 days.

In view of the above, the total delay incurred by Applicant in the ‘454 Application is 444 days.

D. Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer

The ‘454 Application is not subject to a Terminal Disclaimer.

E. The adjustment as specified in 37 C.F.R. § 1.703(f) to which the ‘454 Application is entitled

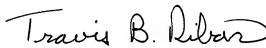
The total amount of patent term adjustment owed to Applicant is specified in 37 C.F.R. § 1.703(f) as being the period of delay attributable to the USPTO under 37 C.F.R. §§ 1.703(a-e) less the amount of delay attributable to Applicant under 37 C.F.R. § 1.704. Accordingly, the ‘454 Application is entitled to at least 471 days of PTA. This number is derived from the sum of the delay attributable to the USPTO under §§ 1.702(a-e) (915 days), minus the sum of the delay attributable to Applicant under § 1.704 (444 days).

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II. CONCLUSION

In summary, Patentee respectfully submits that it is proper that the USPTO grant Patentee's Application for Patent Term Adjustment. Favorable consideration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Travis B. Ribar". The signature is written in a cursive style with a horizontal line underneath the name.

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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 4, 2010

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APPENDIX 1

10/647,454	POLYMER COMPOUND AND POLYMER LIGHT-EMITTING DEVICE USING THE SAME	02-04-2010::14:43:11
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Transaction History

Date	Transaction Description
12-03-2009	Email Notification
12-03-2009	Mail Miscellaneous Communication to Applicant
11-27-2009	Miscellaneous Communication to Applicant - No Action Count
11-24-2009	Information Disclosure Statement considered
11-24-2009	Information Disclosure Statement (IDS) Filed
11-05-2009	Electronic Review
11-05-2009	Email Notification
11-05-2009	Mail Notice of Allowance
11-02-2009	Document Verification
11-02-2009	Notice of Allowance Data Verification Completed
07-06-2009	Information Disclosure Statement considered
07-06-2009	Reference capture on IDS
07-06-2009	Information Disclosure Statement (IDS) Filed
09-02-2009	Date Forwarded to Examiner
07-06-2009	Response after Non-Final Action
07-06-2009	Request for Extension of Time - Granted
07-06-2009	Information Disclosure Statement (IDS) Filed
01-05-2009	Mail Non-Final Rejection
01-02-2009	Non-Final Rejection
10-24-2008	Date Forwarded to Examiner
09-29-2008	Response after Non-Final Action
09-29-2008	Request for Extension of Time - Granted
04-10-2008	Mail Non-Final Rejection
04-08-2008	Non-Final Rejection
03-04-2008	Date Forwarded to Examiner
02-26-2008	Request for Continued Examination (RCE)
03-04-2008	Disposal for a RCE / CPA / R129
02-26-2008	Request for Extension of Time - Granted
02-26-2008	Workflow - Request for RCE - Begin
10-31-2007	Mail Advisory Action (PTOL - 303)
10-29-2007	Advisory Action (PTOL-303)
10-19-2007	Date Forwarded to Examiner
10-18-2007	Amendment/Argument after Notice of Appeal
10-18-2007	Notice of Appeal Filed
10-18-2007	Request for Extension of Time - Granted
10-04-2007	Case Docketed to Examiner in GAU
04-19-2007	Mail Final Rejection (PTOL - 326)
04-16-2007	Final Rejection
02-08-2007	Date Forwarded to Examiner
12-15-2006	Supplemental Response
12-12-2006	Date Forwarded to Examiner
11-20-2006	Response after Non-Final Action
11-20-2006	Request for Extension of Time - Granted
11-20-2006	Substitute Specification Filed
07-06-2006	Correspondence Address Change

05-19-2006	Mail Non-Final Rejection
05-15-2006	Non-Final Rejection
06-13-2005	Information Disclosure Statement considered
03-07-2006	Date Forwarded to Examiner
02-27-2006	Response to Election / Restriction Filed
02-27-2006	Request for Extension of Time - Granted
09-27-2005	Mail Restriction Requirement
09-23-2005	Requirement for Restriction / Election
06-13-2005	Reference capture on IDS
06-13-2005	Information Disclosure Statement (IDS) Filed
06-13-2005	Information Disclosure Statement (IDS) Filed
08-26-2003	Request for Foreign Priority (Priority Papers May Be Included)
08-26-2003	Preliminary Amendment
03-25-2004	IFW TSS Processing by Tech Center Complete
03-25-2004	Case Docketed to Examiner in GAU
02-20-2004	Application Return from OIPE
02-20-2004	Application Return TO OIPE
02-20-2004	Application Dispatched from OIPE
02-20-2004	Application Is Now Complete
01-13-2004	Additional Application Filing Fees
01-13-2004	Small Entity Statement (37 CFR 1.27)
01-13-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant
11-26-2003	Notice Mailed--Application Incomplete--Filing Date Assigned
11-09-2003	Cleared by OIPE CSR
10-09-2003	IFW Scan & PACR Auto Security Review
08-26-2003	Initial Exam Team nn

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